

REMARKS

Claims 1-26 are currently pending in the subject application. Claims 1, 3, 9, 10, 17, 19, and 20 have been amended herein. A clean version of all pending claims is found at pages 2-7 of this Reply. A version with markings to show amendments made is found at pages 12-14 of this Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-17, 19, and 20 Under 35 U.S.C. 112, Second Paragraph

Claims 1-17, 19, and 20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is submitted that this rejection be withdrawn for at least the following reasons.

The Examiner contends that in claim 1, line 7, “the buyer” lacks antecedent basis. Applicant respectfully disagrees. Antecedent basis for “the buyer” is provided at line 4 of claim 1, “inputting a plurality of buying criteria by *a buyer...*” (emphasis added). Claims 3, 9, 10, 17, 19, and 20 have been amended herein to provide sufficient antecedent basis, in accordance with the Examiner’s suggestions. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 1-26 Under 35 U.S.C. 103(a)

Claims 1-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over either Conklin *et al.* (U.S. Patent No. 6,338,050); Conklin *et al.* (U.S. Patent No. 6,336,105); Conklin *et al.* (U.S. Patent No. 6,332,135); or Conklin *et al.* (U.S. Patent No. 6,141,653). It is submitted that this rejection be withdrawn for at least the following reasons.

Neither Conklin *et al.* ‘050, Conklin *et al.* ‘105, Conklin *et al.* ‘135, nor Conklin *et al.* ‘653 (collectively referred to as “the Conklin *et al.* references” herein) teach or suggest offering a plurality of deals by a seller, inputting a plurality of buying criteria by a buyer, and outputting a list of deals that match the buying criteria, as recited in claims 1 and 17. Rather, the Conklin *et*

et al. references describe a buyer electronically searching a sponsored community site for seller of goods meeting the buyer's needs. The sponsored community displays the sellers and the buyer can either link to the sites of the sellers listed or the buyer can send email inquiries to the sellers. In the Conklin *et al.* references, the buyer does not receive a list of deals that match his criteria. Instead, in the Conklin *et al.* references, the buyer merely receives a list of sellers that have goods desired by the buyer.

Moreover, it is submitted that there is no teaching or suggestion in the Conklin *et al.* references to modify the references. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Also, the cited references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed modification or combination and the reasonable expectation of success must both be found in the cited art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

The Office Action of March 28, 2002, states "to provide the terms and conditions each Conklin reference to include at least one of a product and service or different ordering criteria for each Conklin reference would have been obvious to one of ordinary skill in the art. Doing so would bundle the goods and services that is common knowledge in the business transaction world into one package providing a more streamlined business offering." However, the Office Action failed to set forth particular findings to support this conclusion, which showing must be clear and particular. *C.R. Bard, Inc v. M3 Systems, Inc*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998). Also, broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) (*citing, McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d

1129, 1131 (Fed. Cir. 1993)). Moreover, as stated in *Okajima v. Bourdeau*, 261 F.3d 1350, 59 USPQ2d 1795 (Fed. Cir. 2001):

The level of skill in the art is a prism or lens through which a judge, jury, or the Board of Patent Appeals and Interferences views the prior art and the claimed invention. This reference point prevents these factfinders from using their own insight or, worse yet, hindsight, to gauge obviousness. Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies an important guarantee of objectivity in the process.

It is respectfully submitted that the Office has not provided or demonstrated a line of reasoning to show that there is proper motivation to make the suggested combination. The Conklin *et al.* references are directed to displaying sellers to a buyer such that the buyer can either link to the sites of the sellers listed or the buyer can send email inquiries to the sellers, thus, facilitating negotiation between buyers and sellers. Accordingly, it appears that the purported modification of the Conklin *et al.* references is based on improper hindsight, in which the present application provides the teaching and motivation to do so.

Regarding claim 2, the Conklin *et al.* references do not teach or suggest wherein each of a plurality of deals is based on a plurality of selling criteria defined by the seller. Instead, the Conklin *et al.* references describe a buyer entering an order and requesting specific terms and conditions with the order. The seller then reviews the terms and accepts them or counteroffers. The Conklin *et al.* references are silent on matching selling criteria with buying criteria. Rather than automatically matching criteria between a buyer and seller, the Conklin *et al.* references facilitate back and forth negotiations between a buyer and a seller.

For reasons similar to the ones stated above with respect to claims 1 and 2, the Conklin *et al.* references do not teach or suggest an Internet transaction, wherein at least one buyer making a purchase from at least one seller when a plurality of buying criteria defined by the buyer matches a plurality of selling criteria defined by the seller, as recited in claim 9, 19, and 20; an electronic signal comprising an algorithm for matching a buyer with at least one deal based on a plurality of

buying criteria defined by the buyer matching a plurality of selling criteria defined by at least one seller, as recited in claim 18; or a server configured to receive orders for a product from a plurality of different buyers via at least one remote computer system by providing the plurality of buyers with at least one deal of a plurality of deals matching a plurality of buyers defined buying criteria, as recited in claims 21 and 24.

Thus, because the Conklin *et al.* references do not teach or suggest each and every element in recited claims, the Conklin *et al.* references do not make obvious such claims. Accordingly, withdrawal of this rejection and allowance of claims 1-26 are respectfully requested.

III. Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend the claims as follows:

1. (Amended) A business transaction methodology, including [the steps of]:
offering a plurality of deals for at least one of a product and service offered by at least one seller;
inputting a plurality of buying criteria by a buyer for the at least one of a product and service; and
outputting a list of deals from amongst the plurality of deals that match the buying criteria of the buyer.
3. (Amended) The method of claim 2, wherein each of the plurality of selling criteria defined by the seller includes an offering criteria which defines [the] limits of each of the plurality of selling criteria defined by the seller.
9. (Amended) An Internet business transaction system, including:
a computer adapted to be employed by a facilitator for hosting [a commercial transaction over the Internet] an Internet based transaction, the computer providing access to at least one buyer and at least one seller to carry out the commercial transaction, wherein at least one buyer makes a purchase from the at least one seller when a plurality of buying criteria defined by the buyer matches a plurality of selling criteria defined by the seller.
10. (Amended) The system of claim 9, wherein each of the plurality of selling criteria defined by the seller includes an offering criteria which defines [the] limits of the each of the plurality of selling criteria defined by the seller.

17. (Amended) A method of conducting a business transaction, comprising [the steps of]:

electronically offering a plurality of deals on at least one of a product and service for sale, each of said plurality of deals being based on different offering criteria than each other of said plurality of deals;

electronically searching the deals on the product for sale based on a plurality of ordering criteria;

outputting a list of deals of the plurality of deals which offering criteria matches the ordering criteria; and

selecting one of the deals of the list of deals which offering criteria matches the ordering criteria.

19. (Amended) An Internet business transaction system, including:

means for hosting a commercial transaction over the Internet, the means for hosting providing access to at least one buyer and at least one seller to carry out the commercial transaction, wherein the at least one buyer makes a purchase from the at least one seller when a plurality of ordering criteria, fall within [the] outer limits of a plurality of offering criteria, each ordering criteria being based on a buyer defined buying criteria, and each offering criteria being defined by the seller.

20. (Amended) An Internet business transaction system, including:

a first computer adapted to be employed by a facilitator for hosting [a commercial transaction over the Internet] an Internet based transaction;

a second computer adapted to be used by a buyer to link to the first computer to participate in the commercial transaction;

a third computer adapted to be used by a seller to link to the first computer to participate in the commercial transaction;

wherein the buyer makes a purchase from the seller when a plurality of buyer defined buying criteria matches a plurality of seller defined selling criteria.